

Appl. No. 10/618,150
Amdt. dated August 4, 2005
Reply to Office Action of May 4, 2005

Docket No. 53436-014100

RESPONSE TO EXAMINER'S REJECTIONS/OBJECTIONS

Responsive to the Office Action mailed May 4, 2005, the Applicant has amended Claims 1, 5, 8, 9, 15, 19, 25, 32, 35, 38, 42-44, 49, and 50. No new subject matter has been added to these amended claims.

Claim Rejections - 35 U.S.C. § 102(b)

Examiner has rejected Claims 1-8, 11, 13, 15-18, 21, 23, 25-38, 43-44, and 50 under 35 U.S.C. § 102(b) as being anticipated by D'Urso et al. (U.S. 5,353,335). However, in D'Urso does not teach all of the elements of these claims. The Federal Circuit states that "all elements of the claimed invention must be disclosed in a single reference for anticipation to exist." Atlas Powder Co. v. E. I. DuPont de Nemours & Co., 750 F.2d 1569, 224 U.S.P.Q. 409 (Fed. Cir. 1984). Furthermore, missing elements cannot be supplied by the knowledge of one skilled in the art or the disclosure of another reference in order to give rise to an anticipation rejection. Structural Rubber Products Co. v. Park Rubber Co., 749 F.2d 707, 223 U.S.P.Q. 1264 (Fed. Cir. 1984).

D'Urso does not teach a card having associated with it redeemable units of live interpretation services. Instead, D'Urso teaches a card for telephone services where the system has prompts and announcements in a particular language so that the user can understand the instructions. Moreover, the D'Urso card only has an automated, pre-recorded specific language messages so that the user can understand the instructions for placing call. Thus, the card of D'Urso merely uses different languages to facilitate placing a phone call. For example, see column 3, lines 2-17 (as cited by the Examiner, emphasis added) :

"In one example of the invention, a different card may be sold for each of the languages supported by the system. In this example, only the 800 number for the language of each card needs to be printed on the card. Instructions about how to use the card may be given in that language on the card. The system may support any of a plurality of desired languages such as English, Spanish, French, Japanese, German, Italian, Swedish, Dutch, Korean, Chinese, and other languages. The system will prompt the card holder in the selected language to enter a card number and a destination number. The card number is verified,

Appl. No. 10/618,150
Amdt. dated August 4, 2005
Reply to Office Action of May 4, 2005

Docket No. 53436-014100

the available balance is determined, and the desired call is completed, if there is a sufficient credit balance. If there is an insufficient credit balance, an appropriate announcement is played in the selected language and the caller is disconnected.”

Accordingly, applicant has amended the independent claims (Claims 1, 5, 9, 15, 19, 25, 32, 35, 31, 42, 43, 44, 49, and 50) to further clarify that the portable language interpretation services in these claims is not the same as disclosed in D’Urso. Specifically, applicant has amended these independent claims to include the term “live” to further emphasize the methods claimed are that of offering a live, interpretation service. This is fully supported in the specification as filed in paragraphs [0009], [0014], and [0048]. For example, paragraph [0009] states:

“The system and method of the present invention allows for access to live interpretation services anywhere in the world. Specifically, the method involves providing over the phone interpretation services to a user such as a traveler through the use of a portable system, for instance a pre-paid card, or other prepaid medium. Quality, live, professional language interpretation, as is offered by the present invention, can turn a barely discernable communication into a clearly understood conversation between people of different languages...”

Again, D’Urso does not disclose any sort of live language interpretation service. In light of these amendments and arguments, Applicant has overcome the Examiner’s 35 U.S.C. § 102(b) rejections. Thus, the Examiner is respectfully requested to withdraw these rejections with respect to Claims 1, 5, 9, 15, 19, 25, 32, 35, 31, 42, 43, 44, 49, and 50.

Claim Rejections - 35 U.S.C. § 103(a)

Examiner has rejected Claims 9-10, 12, 14, 19-20, 22, 24, 39-42, 45-48, and 49 under 35 U.S.C. 103(a) as being unpatentable over D’Urso et al. in view of Hanson (US Patent No. 6,208,851). However, as discussed above, D’Urso does not disclose the same elements of the present claims. To establish *prima facie* obviousness of a claimed invention, all the claim

Appl. No. 10/618,150
Amdt. dated August 4, 2005
Reply to Office Action of May 4, 2005

Docket No. 53436-014100

limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970). Therefore, because all the claims limitations are not taught or suggested by D'Urso alone or in combination with Hanson, they cannot be used as the basis of a 103 rejection. Further, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). In light of these amendments and arguments, Applicant has overcome the Examiner's 35 U.S.C. § 103(a) rejections. Thus, the Examiner is respectfully requested to withdraw these rejections with respect to Claims 9-10, 12, 14, 19-20, 22, 24, 39-42, 45-48, and 49.

Appl. No. 10/618,150
Amdt. dated August 4, 2005
Reply to Office Action of May 4, 2005

Docket No. 53436-014100

REMARKS

Applicant has complied with all requirements made in the above-referenced communication. In view of the foregoing, it is respectfully submitted that the pending Claims in the application are in condition for allowance. Allowance of the pending claims at an early date is courteously solicited.

If, for any reason, the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call Applicant's undersigned representatives, attention Eglia Nair Flores at (310) 586-6511 to discuss the steps necessary for placing the application in condition for allowance.


This response is being timely filed and no fee is believed due. However, if Applicant is mistaken, the Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that Attorney Docket Number 53436-014100 is referred to when charging any payments or credits for this case.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Date: August 4, 2005

By


Eglia Nair Flores
Reg. No. 54,103

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-6511
Fax: (310) 586-0511
E-mail: floresn@gtlaw.com